

REMARKS

Claims 1-16 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

Applicants further submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner. In particular, Applicants have not amended the claims at all. Accordingly, the Examiner is not presented with the burden of additional search and/or consideration. Thus, no new issues have been raised.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-16 under 35 U.S.C. § 112, first paragraph, asserting that these claims fail to comply with

the written description requirement. Applicants respectfully traverse.

This is the same rejection raised by the Examiner in parent Application No. 09/995,681. All arguments raised by Applicants in the parent application are herein incorporated. The Examiner is requested to reconsider this rejection based upon the arguments in the parent application as well as the following additional arguments.

The Examiner asserts that the specification fails to contain a written description of the processes as set forth in the claims wherein the last step of heating the non-stick sheet to drive the dry peel coating into the receptor element is not limited to hand ironing. The Examiner acknowledges that the present specification incorporates the disclosure of the provisional application 60/013,193 which discloses processes encompassed by the instant claims, by incorporation by reference. However, the Examiner asserts that the provisional application does not disclose any heat press or generic heating for the last step of the instant claims of heating through the non-stick sheet. The Examiner acknowledges that the heat press is disclosed in the discussion of processes as using a hot peel without the step of peeling the image coating from its support prior to heating (by either heat press or hand ironing)

as required by the instant claims. However, the Examiner asserts that in the process of the present claims the specification does not disclose the use of a heat press or generic heating in the last step. Applicants respectfully disagree with the Examiner.

Applicants respectfully submit that the hand ironing in relation to the presently claimed invention is simply a preferred method of transfer. However, other methods of application of pressure and heat are known in the art. For instance, page 18, lines 27-32 explains the method of transferring are known in the art. Such methods include the use of a heat press. Although there may not be word for word support linking the use of generic heat or a heat press with the presently claimed method, such specific support is not required to satisfy 35 U.S.C. § 112, first paragraph, written description.

The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112, first paragraph. In re Lukach et al., 169 USPQ 795, 796 (CCPA 1971). To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the

claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

Importantly, a patent specification must contain a written description of the invention sufficient to "allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) (quoting In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)).

In the present instance, the background of the invention explains that commercial heat presses are costly and inconvenient. It is true that the use of a hand iron, for instance in connection with the presently claimed method, reduces the expenses associated with the heat press. The issuance of the parent application Serial No. 09/995,681, now U.S. Patent No. 6,638,682 relates to the use of a hand iron. However, the use of a hand iron is simply one embodiment which is disclosed in connection with the present method. Those of skill in the art fully understand that the possession of the invention with respect to a hand iron necessarily implies the possession of the invention with respect to the heat press.

The importance of the last step in the present method is to provide sufficient heat and pressure to drive the coatings into the receptor element. Those of skill in the art understand, at the time of filing the present application, that Applicants were in possession of not only the use of a hand iron, but also the use of a heat press. In fact, any known means for applying heat and pressure is possessed, and therefore has sufficient written description in the present specification.

The case of Gentry Gallery, 45 USPQ2d 1498 (Fed. Cir. 1998) was discussed above.

Gentry involved a patent that related to two recliner seats facing the same way within one sectional sofa by having a fixed console between them, which contains the controls for the recliners. Prior to this invention, two recliners within a typical sectional sofa had to face different directions because the controls were in the armrests at the outer edges of the L shaped sectional. The Federal Circuit determined that the location of the controls for the recliners had to be on the fixed console because that was the invention contemplated. Gentry, 134 F.3d at 1480, 45 USPQ2d at 1503. Accordingly, when one of the claims did not specify this location restriction, this court determined that it was lacking an essential element of the invention and therefore

violated the written description requirement of 35 U.S.C. § 112, first paragraph.

It is important to fully understand the scope of the Federal Circuit's holding in Gentry. Gentry should only be applied when the omitted limitation is an important or critical part of the invention, distinguishing it from prior art. In fact, the Federal Circuit explained that Gentry "considers the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an 'essential element of [the inventor's] invention'." Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999).

For instance, in Gentry, the court's determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element, the "control means," as "the only possible location" and that variations were "outside the stated purpose of the invention." Gentry, 134 F.3d at 1479, 45 USPQ2d at 1503.

Applicants submit that the present situation does not rise to the level of Gentry. In Gentry, there were clear statements that the only possible location for the controls for the recliners had

to be on the fixed console. In fact, evidence indicated that the inventor in Gentry did not even contemplate placing the controls elsewhere. Johnson Worldwide characterized Gentry as relating to the situation where the patent's disclosure makes "crystal clear" that a particular (i.e., narrow) understanding of a claim term is an "essential" element of the inventor's invention."

In contrast, the present specification does not contain "crystal clear" statements that the technique of transfer using a "hand iron" is an essential element of the invention. The use of a hand iron is disclosed in conjunction with the claimed method, but this is simply the disclosure of one embodiment or a preferred example. Applicants should not be limited to a single embodiment. The statements from the description of the preferred embodiment are simply that—descriptions of a preferred embodiment. Absent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context. See Teleflex, 299 F.3d at 1328, 63 USPQ2d at 1382-83; Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

Further, the present facts do not involve a situation where the inventors failed to contemplate the use of anything other than

a hand iron to achieve the presently claimed transfer. The present inventors simply contemplated the use of a hand iron as being more cost effective than other sources of heat and pressure, for instance a heat press.

Also, cost effectiveness is not the only disclosed advantage of the present transfer method. Cost effectiveness factors into the use of hand iron; however other advantages of the present transfer process exist which are unrelated to nature of the source of the heat and pressure.

At page 18, line 7 of the present specification it is disclosed that by using the present transfer method "[a]n easy and complete peel of paper will result." The specification goes on to explain that:

The cause for the ease and totality of the paper release is the result of the coatings first having been removed from the support sheet which had to have been thicker, more steady, and a restriction of heat permeability to carry the coatings then the printing process. (page 18, lines 8-13).

Another advantage of the present method is that it is not necessary to print the image in reverse on the transfer media so that it will appear correctly during a conventional transfer wherein the support is peeled after ironing. As disclosed in a Comparative Example of the present invention, such "reverse" printing is required in such a transfer. See Comparative Example,

in particular disclosure at page 48, lines 24-31 of the present specification. However, it is immediately apparent that such "reverse" printing is unnecessary in the presently claimed method since the peeled and imaged transfer media need not be placed face down, but rather face up on the receptor element. This advantage is unrelated to the method of applying heat or pressure and this is fully understood by those of skill in the art.

In summary, Applicants respectfully submit that those of skill in the art fully understand that Applicants were in possession of the invention as claimed at the time of filing. As such, the Examiner is respectfully requested to withdraw this rejection. Further, as discussed above, Applicants submit that the present specification and claims are distinguished from cases such as Gentry, since there is no "crystal clear" indication that the use of a hand iron is an essential element of the invention.

Reconsideration and withdrawal of the outstanding rejection and allowance of the present application is respectfully solicited.

Obviousness-Type Double Patenting

The Examiner has rejected claims 1-16 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-16 of USP 6,638,682. A Terminal Disclaimer

Appl. No. 10/628,491

relating to USP 6,638,682 (the parent application) was previously approved. See Advisory Action dated December 8, 2004. Accordingly, this rejection is moot. Withdrawal thereof is respectfully requested.

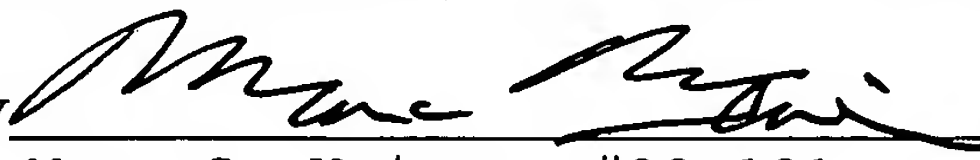
If the Examiner has any questions or comments, please contact Craig A. McRobbie, Reg. No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to December 13, 2004 in which to file a reply to the Office Action. The required fee of \$215.00 was previously submitted with the Amendment filed on November 24, 2004.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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